



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/817,597	03/26/2001	Motoki Nakade	450100-03084	7826

20999 7590 03/12/2008
FROMMER LAWRENCE & HAUG
745 FIFTH AVENUE- 10TH FL.
NEW YORK, NY 10151

EXAMINER

JOHNS, CHRISTOPHER C

ART UNIT	PAPER NUMBER
----------	--------------

3621

MAIL DATE	DELIVERY MODE
-----------	---------------

03/12/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/817,597	Applicant(s) NAKADE ET AL.	
	Examiner Christopher C. Johns	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,7,8 and 10-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,7,8 and 10-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination ("RCE") under 37 CFR 1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal. Since this application is eligible for continued examination under 37 C.F.R. §1.114 and the fee set forth in 37 C.F.R. §1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 C.F.R. §1.114 and prosecution in this application has been reopened pursuant to 37 C.F.R. §1.114. Applicant's submission filed on 30 November 2007 has been entered.

Acknowledgments

2. The Examiner thanks Applicants for their Request for Continued Examination (RCE) of 11/30/2007. In said RCE, claims 1, 3, 4, 7, 8, 10, 12-14, and 17 were amended. Claims 2, 11, 15, 16, 18, 19, 20, 21, and 22 were left unchanged. Finally, claims 1-4, 7, 8, and 10-22 are pending.

Claim Rejections - 35 USC § 103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1-4, 7, 8, 12-19, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nachom (U.S. Patent 7,072,856) ("Nachom").

5. **As per claims 1-4, 7, 8, 12-19, and 22, Nachom teaches:**

Art Unit: 3621

- a. connecting a plurality of communication terminals to each other and transmitting signals between said terminals (figures 1 and 2);
- b. superposing a second advertisement image over a first image and transmitting the superposed image to a user (figure 2; column 5, lines 10-33);
- c. transmitting advertisements to users of said terminals (figure 2; column 5, lines 10-33) and providing information to said users in response to a demand from said users (column 5, lines 33-43);
- d. superposed image data (see figure 2, reference number 26 – the question mark bubble is an image. It is the Examiner's primary position that the claims are anticipated because of the above inherent features (*i.e.* the pop-up may contain image data). However, if not inherent, advertisements that contain images were old and well-known to those skilled in the art at the time of the invention (see "Ad Blockers Challenge Web Pitchmen", story from Los Angeles Times, 2 March 1999, hereafter "Blockers": page 3, 2nd paragraph, 4th paragraph). Since Nachom uses pop-ups for its advertisements, it would have been obvious to one of ordinary skill in the art at the time of the invention to use images in the pop-ups described in Nachom).
- e. displaying a transaction environment to the users (column 5, line 43 – column 6, line 6);
- f. replacing an area of the first image data with the second image data and blending the data at a prescribed ratio (see column 5, lines 30-35

Art Unit: 3621

– “Information may be presented in the form of a pop-up screen or an embedded hyperlink”. Using a pop-up screen is a method that replaces a prescribed area of the first image data (the original webpage, figure 2, reference number 20) with second image data. Again, it is the Examiner’s primary position that the claims are anticipated because of the above inherent features (i.e. blending image data to a “prescribed ratio”).

However, if not inherent, blending two images was well-known to those skilled in the art at the time of the invention (see “Play your cards right”, article from vnunet.com, 24 July 1999 (hereafter “Cards”), section: “Glossary of common 3d terms”, definition “Alpha blending/transparency”).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the transparency idea in Cards with the system in Nachom, because it produces the effect of objects appearing in front of one another, which produces a more aesthetically pleasing effect, for a more robust system);

- g. sending the superposed image based on the first user (advertiser) and a second user (consumer) (column 5, line 10 – column 6, line 44);
- h. transmitting data over the Internet (column 4, lines 50-61), therefore transmitting data and signals that the Internet typically supports – such as the JPEG, GIF, MPEG, MP3 file formats (well-known to those skilled in the art at the time of the invention)

Art Unit: 3621

- i. a user completing a transaction at a second site, accessed by clicking on said pop-up ads (see abstract; figure 2, reference numbers 34-40-44, 50, 52 *et seq*);
 - j. As per claims 3, 4, 7, 8, and 18, data stored in memory that does not affect a claimed method or apparatus does not distinguish the claims from the prior art (see MPEP 2106.01). Similarly how stored data in memory is arranged for display does not distinguish the claims from prior art (claims 7, 8).
 - k. As per claim 13, websites that sell multiple products were old and well-known to those skilled in the art at the time of the invention (such as Amazon.com, Buy.com, etc). As Nachom applies his system to companies that perform business over the Internet (column 5, lines 25-50), it would have been obvious to one of ordinary skill in the art at the time of the invention to use Nachom to sell multiple products.
6. Claims 10, 11, 20, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nachom, in view of US Patent 5,721,827 (hereafter “Logan”).
- l. **As per claims 10, 11, 20, and 21**, Nachom does not explicitly teach compensating a user for viewing advertisements. Logan teaches compensating a user for viewing an ad (see abstract). Logan also teaches targeting advertisements to users based on user preferences (column 9, line 12 – column 10, line 5). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to

Art Unit: 3621

compensate the users for advertisements as is done in Logan, in the system in Nachom, because it would provide a more successful system where more users will click advertisements (because of the obvious financial benefits).

Response to Arguments

7. Applicant's arguments with respect to claims 1 and 14, pertaining to the superposition of image data using blending, have been considered but are moot in view of the new ground(s) of rejection.

8. Further arguments filed 30 November 2007 have been fully considered but they are not persuasive. The first argument concerning the popup screen containing no image data is rejected above, and the argument concerning simultaneous sending of data is covered below.

9. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the popup screen being sent "separately from the transmitting of the other webpage") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Art Unit: 3621

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher C. Johns whose telephone number is (571)270-3462. The examiner can normally be reached on Monday - Friday, 9 am to 5 pm.

11. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Christopher C Johns
Examiner
Art Unit 3621

/ANDREW J. FISCHER/
Supervisory Patent Examiner, Art Unit 3621